

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 10/31/2004. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

2038-323

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/764,589

Filed

January 27, 2004

First Named Inventor

Takaaki SHIMADA

Art Unit

3761

Examiner

Chivonne Laurie Evans

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record. 29,310

Registration number \_\_\_\_\_

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_


Signature  
Benjamin Hauptman

Typed or printed name

703-684-1111

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	:	EXPEDITED PROCEDURE
	:	:	Response under 37 CFR 1.116
Takaaki SHIMADA et al.	:	:	
	:	:	
Serial No. 10/764,589	:	:	Group Art Unit: 3761
	:	:	
Filed: July 6, 2007	:	:	Examiner: Melanie Jo Hand
	:	:	

For: PANTS-TYPE DISPOSABLE WEARING ARTICLE

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed *March 14, 2007*.

Applicants respectfully request review of the final rejections of claims **4-6, 11-16, and 18-22** as manifested in the Final Office Action. No amendments are being filed *with* this request.<sup>1</sup>

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

---

<sup>1</sup> An after-final Amendment was file on June 14, 2007 to place the claims on appeal in better form, but was improperly denied entry by Examiner Hand.

**REASONS**

The clear errors found in Examiner Hand's final rejections of claims 4-6, 11-16, and 18-22 have been discussed in the June 14, 2007 Amendment, at page 10 line 9 from bottom to page 15, line 11 from bottom, which is incorporated by reference herein.

### **OTHER ISSUES**

Although not reviewable by a pre-appeal brief review panel, the following clear errors are also found in Examiner Hand's advisory action mailed July 6, 2007: Examiner Hand erroneously denied entry of the June 14, 2007 Amendment which only cancels claims 1-3, 7-10 and 17 and presents claims 4, 11, 13 and 18 in independent form, without changing the scope of any claim.

Contrary to Examiner Hand's allegation,<sup>2</sup> rewritten claim 4 does not include claims 2-3.<sup>3</sup> Rewritten claim 4 consists only of the limitations of previously presented claims 1 and 4. Rewritten claim 4 does not change the scope of any of claims 5-6 and 22 depending therefrom, requires no further search, and raises no new issue.

Examiner Hand's statement<sup>4</sup> regarding claims 11, 13 and 18 as requiring further consideration even though the claims remain unchanged in scope is wrong on its face.

Contrary to Examiner Hand's allegation,<sup>5</sup> claims 21-22 are not new and have been considered by Examiner Hand in her Final Office Action of March 14, 2007.

Examiner Hand's allegation<sup>6</sup> that the June 14, 2007 Amendment does not place the application in better condition for appeal is also wrong, because the June 14, 2007 Amendment not only places the claims on appeal, i.e., claims 4-6, 11-16, and 18-22, in better form, but also simplifies the issues for appeal by canceling claims 1-3, 7-10 and 17.

---

<sup>2</sup> See the July 6, 2007 Advisory Action, continuation page, line 1.

<sup>3</sup> Compare, for example, claims 2-3 as presented in the last entered December 11, 2006 Amendment at page 3 with rewritten claim 4 as presented in the June 14, 2007 Amendment.

<sup>4</sup> See the July 6, 2007 Advisory Action, continuation page, lines 3-7.

<sup>5</sup> See the July 6, 2007 Advisory Action, continuation page, line 8.

<sup>6</sup> See the July 6, 2007 Advisory Action, continuation page, lines 1-8 from bottom.

Withdrawal of the final rejections of claims 4-6, 11-16, and 18-22 in view of the arguments incorporated by reference in the Reasons section above is believed appropriate and therefore respectfully requested. If the final rejections are to be sustained, entry of the June 14, 2007 Amendment for purposes of appeal is hereby respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

**LOWE HAUPTMAN & BERNER, LLP**



Benjamin J. Hauptman  
Registration No. 29,310

USPTO Customer No. 22429  
1700 Diagonal Road, Suite 310  
Alexandria, VA 22314  
(703) 684-1111  
(703) 518-5499 Facsimile  
Date: July 13, 2007  
BJH/KL/mps